BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

First Named Inventor	:	MICHEL, Paul
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MAIL STOP: APPEAL BRIEF - PATENTS
Honorable Commissioner of Patents & Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Applicant's Appeal Brief follows.

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REAL PARTY IN INTEREST

The real party in interest is the assignee of the patent application, Electronics For Imaging, Inc., having an address at 303 Velocity Way, Foster City, California 94404. Electronics For Imaging, Inc. interest in the application is the subject of a recorded assignment which appears at Reel/Frame 014354/0513.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

The status of the claims is as follows:

Claims 1-26, and 28-33 are rejected. Claims 1-9 have been cancelled; Claims 10-26 and 28-33 are on appeal.

STATUS OF AMENDMENTS

Applicant's communication filed 20 February 2008 was considered and entered, as indicated in the Advisory Action, dated 20 March 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention is concerned with a method for analyzing a print job, as set forth in independent Claim 10 as follows[*]:

10.   (Previously Presented) A method for analyzing a print job comprising an object having an associated print attribute, the method comprising:

determining a print attribute of interest [Figures 4:60; Page 10:1-2];

associating a corresponding unique marker to the determined attribute [Figure 40:62; Page 10:1-14];

receiving page description language ("PDL") commands that describe the print job [Figure 7:82; Page 10:29-33];

interpreting the PDL commands to process the object [Figure 7:84; Page 10:33-Page 11:1];

determining if the attribute associated with the processed object matches the determined attribute [Figure 7:86; Page 11:1-7], and

reporting the results of any matched object using the corresponding unique marker [Figure 7:92; Page 11:7-8].

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[*] Figures showing support for the claim elements are cited within brackets, with numeric designators for the claim element identified after a colon; supporting page numbers in the Specification are also set forth in brackets with line numbers following a colon.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds for rejection are to be reviewed on appeal:

Whether the subject matter of Claims 10-26 and 28-33 is anticipated under 35 U.S.C 102(E) by Jackelen *et al* (U.S. Publication Number 2003/0053810, now U.S. Patent Number 6,823,147).

ARGUMENTS

Claims 10-26 and 28-33 stand rejected under 35 USC 102(e) as anticipated by Jackelen (U.S. Publication Number 2003/0053810 A1, now U.S. Patent Number 6,823,147 B1).

The rejection of Claims 10-26 and 28-33 will be discussed by reference to independent Claim 10.

Legal Precedent

MPEP 2131 addresses the issue of anticipation under 35 USC 102(e). In particular, the Examiner is taught that "to anticipate a claim, the reference much teach every element of the claim. A claim is anticipated only if each and every element as set forth and the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.1987).

As will become clearer in the following discussion, the Examiner has failed to apply the guidelines of the United States Patent and Trademark Office in connection with 35 USC 102(e) in making a determination of anticipation. That is, the Examiner has failed to provide a reference that shows each and every element of the claimed invention.

The Examiner's most recent statement of her rejection appears in the Advisory Action before the filing of an Appeal Brief, which has a mailing date of 3/20/2008. The Examiner's argument may be summarized as follows:

One, Jakelen (U.S. Publication Number 2003/0053810, now U.S. Patent Number 6,823,147) discloses a printer 21 which receives a print job from the network. The print job header is parsed and the print job attributes are determined. The Examiner relies on paragraph [0018], lines 1 through 5 of Jakelen for this proposition. The Examiner concludes

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that the object is the print job which has a print job header.

The Examiner also maintains that Jakelen discloses a pre-job matching or association with printer resources and capabilities. That is, the corresponding unique marker is considered to be the printer resource and capabilities which determine the attribute. For this, the Examiner relies on paragraph [0018], lines 6-9, of Jakelen.

The Examiner also concludes that Jakelen discloses that the print job attributes are determined, or it is determined, if the job is associated with the printer resources or capabilities. Here the Examiner relies on paragraph [0019], lines 4-9.

Finally, the Examiner maintains that Jakelen discloses a situation wherein if a mismatch is detected between the print job attribute and the printer resource, which is considered as unique matchmaker, a message is displayed on the printer user interface informing the user about the mismatched state. For this, the Examiner relies on paragraph [0020], lines 1-6 of Jakelen.

However, this is at best a gross distortion and misunderstanding of the teachings of Jakelen, as well as a misapplication of Jakelen to the claimed invention. What Jakelen, in fact, teaches is a very simple system that is not unlike the printer described by the inventor in the patent application.

For example, Applicant provides a Figure 1 which teaches a conventional digital network according to the prior art. Applicant discusses this in the Specification beginning on page 1 at line 24. More particularly, Applicant refers to pre-flight (page 1, line 38) that compares data in the source file to a set of rules, also called a "pre-flight profile." Applicant's description continues on page 2, for example, where Applicant states that "a pre-flight profile for a particular printer may include a set of parameters listing the native fonts installed in the printer, the resolution range of the printer, and other printer parameters. If

the source file includes text and a font that is not installed on the specified printer, the pre-flight program may report that file -- that the file may not be printed unless the font is provided to the printer as part of the print job."

This is quite similar to the teaching of Jakelen, for example, where Jakelen is concerned with detecting mismatches between a print job and a printer. A distinction between Applicant's recognized prior art and the teaching of Jakelen is that Jakelen tries to recognize these mismatches during the rendering of a print job and then notifies the operator of such mismatches, for example see the Summary of Invention section of Jakelen.

Unlike Applicant's described printer and unlike Jakelen, the invention, as claimed, is concerned with analyzing objects within a print job and identifying the attributes of objects. Once these objects are identified and a print attribute associated with the object is determined, a marker is associated with the attribute. Page description language commands which describe the print job are received and are interpreted to process the object. A determination is then made if the attribute associated with the object matches the determined attribute. If the attribute associated with an object matches or does not match the determined attribute of the object within the print job, then an appropriate report is made in that regard. Uniquely, the invention identifies print attributes and associates markers with the attributes. Nowhere in the art of record is there any discussion of identifying print attributes and associating markers therewith. Nor is there any indication in the art of record that PDL commands in a print job are interpreted in connection with an object, nor that a determination is made if an attribute associated with an object matches an attribute.

The Examiner has placed much weight on the fact that Jakelen refers to detecting mismatches between print job attributes and printer resources and capabilities that arise after rendering a print job has begun, but before rendering is complete. However, there is a

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distinction to be made between a print job and an object. Key to the claimed invention is the analyzing of a print job comprising objects having associated print attributes, and the association of markers to the attributes. In contrast to that, Jakelen [0018] discusses the parsing of a print job header to determine print job attributes. A print job header is just that, a description at the beginning of a print job, such as the directions for printing pages of the print job, including media size, color, font, and the like. See [0015].) Thus, these aspects of the print job are known in advance for the entire print job. Jakelen teaches that this predetermined information may be parsed during the process into the print job and compared against a printer description to determine if the printer provides the resources necessary for the print job.

The claimed invention does not rely on a print job header, but rather determines which objects comprise the print job and which attributes are associated with the objects within the print job. A PDL file, as considered in the invention comprises many objects. Thus, while Jakelen is concerned with an entire print job having a single header defining attributes of the entire print job, the claimed invention is concerned with a print job comprising many objects, each of which has a determined attribute, as identified by a unique marker. On page 8, lines 20-22, Applicant indicates that print objects can include such things as pages, text, images, and graphics. Each of these may be treated differently, depending on their attributes. The invention seeks to analyze a print job for each of the objects within the print job, and not just based upon a header attached to the print job for the entire print job. Clearly, the claimed invention cannot be read to cover Jakelen. Accordingly, the Examiner is in clear error in determining that the parsing of a header in a print job is an anticipation of the association of markers to attributes in connection with objects within a print job.

Turning now to Applicant's claims, e.g. Claim 10, the preamble recites that the method is concerned with analyzing a print job comprising an object having an associated print attribute. Applicant appreciates that the preamble is not given a great deal of weight in

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determining the scope of the claim. For purposes of anticipation, the subject matter of the asserted reference should be found to be read upon by the preamble of the claim. However, Applicant cannot read Claim 10 upon Jakelen. In particular, Jakelen is not concerned with a print job comprising object having an associated print attribute. Rather, Jakelen is concerned with a print job having a print header that describes the attributes of a print job. There is no notion of an object in Jakelen. Applicant makes it clear in the Specification what is meant by an object. No such discussion is provided by Jakelen and one must conclude that Jakelen is concerned merely with parsing the header of a print job during the processing of the print job to determine the print attributes of the job in its entirety. Applicant's invention is not concerned with this, but is rather concerned with objects within a print job that have print attributes.

Applicant includes a step of determining a print attribute of interest. Applicant can find no teaching of a step in Jakelen for determining a print attribute of interest. It is true that Jakelen parses the header of a print job and determines if there is a match between the print attributes defined in the header and the printer upon which the job is to be printed. However this is different than determining a print attribute of interest. This is particularly true in connection with the next step of Applicant's claim, which associates a corresponding unique marker to the determined attribute. There is no notion of a marker found anywhere in Jakelen. The information contained in the print job header of Jakelen is not a marker in any way that is associated with a print attribute that is determined in connection with an object. Again, the antecedent of an object is not found anywhere in Jakelen, and therefore is not possible to associate a marker with a determined attribute in connection with such objects. Clearly, the providing of a header in Jakelen that contains print attributes is only provided in connection with an entire print job.

Applicant's invention interprets PDL commands to process the object. In Jakelen there is no object to process, there is only the print job itself. The print job is the entire print job, while the object is an object within the print job. Again, Applicant has defined the invention

such that the objects include such things as pages, text, images, and graphics included in the print job. Accordingly, it is not possible to find the teaching in Jakelen of a determination of whether or not an attribute associated with the processed object matches a determined attribute. Again, Jakelen is not concerned with objects. Jakelen does not interpret PDL commands to process objects. In fact, Jakelen teaches that this is unnecessary to do this because Jakelen is merely concerned with matching the print attributes in the header to a printer description. Jakelen would have no need to process the objects within the print job to determine attributes associated therewith.

Finally, the invention reports the results that match objects using a unique marker. Again, there is no matching of objects in Jakelen and no associating of markers with print attributes. As such, Jakelen bears no relation to the claimed invention and does not, therefore, anticipate the claimed invention. That is, not only does Jakelen not teach every element of the claimed invention, it teaches none of the elements of the claimed invention.

In summary, the Applicant respectfully submits that the Examiner has erred, and should be reversed by this Board for holding that Jakelen, by teaching a print job which has a print job header, has not taught the object as claimed by Applicant. As a further point in this regard, the Applicant does not understand how the Examiner can conclude that Applicant's object comprises both the print job and the print job header. There is no fair or rational basis for assigning both roles to Applicant's object, particularly because no such object is defined or discussed in Jakelen.

The Examiner has also erred in concluding that Jakelen discloses print job matching or association with the printer resources and capabilities and that a unique marker is provided in Jakelen. In particular, paragraph [0018] which is referred to by the Examiner, is concerned with parsing a print header while the print job is being executed. Jakelen contains many disclosures of the fact that it is concerned with performing a check during the processing of a print job. As such, it is not possible to find a pre-job matching or

association in Jakelen. Further, where in Jakelen is there any teaching of a marker? The Examiner has indicated that she considers the object to be both the print job and the print job header. Now the Examiner has a new definition for Applicant's marker.

The Examiner has erred in stating that Jakelen discloses the checking of print job attributes and the determination if a printer resource exists or not. Applicant has not claimed this, Applicant has claimed the processing of objects. There are no such objects in Jakelen.

Finally, the Examiner's erred in stating that "Jakelen discloses where and if a mismathc (sic) is detected between the print job attribute and the printer resource which is considered as a unique matchmaker, a message displayed on the printer [unintelligible] informing the user about the mismatched state." Jakelen has nothing to do with using markers (incorrectly referred to by the Examiner as a "maker").

Thus, while Jakelen teaches a technique for parsing a header of a print job while the print job is processing to determine if there is a match between the requirements of the job and the printer, the claimed invention is concerned with analyzing the objects within a print job to determine print attributes thereof and to assign to each a unique marker. Based on this assigning of markers to attributes in connection with individual objects within a print job, the invention interprets PDL commands to process the object and determine if an attribute associated with the process object matches a determined attribute for the object. Thus, the invention is suited for addressing such problems as those that might occur while printing a print job having objects of many different types where knowledge of the requirements of each object is necessary to assure proper printing of a print job. This level of resolution is not possible with Jakelen.

In view of the foregoing, the Applicant submits that the Examiner has failed to establish anticipation with regard to the claims of record. As noted in detail above, the Examiner

has failed to find teachings of each and every element of the claimed invention. Applicant respectfully requests that the Board reverse the Examiner and find for Applicant, such that Applicant may enjoy protection of their invention via U.S. Letters Patent.

Respectfully submitted,

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CLAIMS APPENDIX

10.   A method for analyzing a print job comprising an object having an associated print attribute, the method comprising:

determining a print attribute of interest;

associating a corresponding unique marker to the determined attribute;

receiving page description language ("PDL") commands that describe the print job;

interpreting the PDL commands to process the object;

determining if the attribute associated with the processed object matches the determined attribute; and

reporting the results of any matched object using the corresponding unique marker.

11.   The method of claim 10, wherein the PDL commands comprise PostScript commands.

12.   The method of claim 10, wherein the PDL commands comprise PCL commands.

13.   The method of claim 10, wherein the object comprises text.

14.   The method of claim 10, wherein the object comprises an image.

15.   The method of claim 10, wherein the object comprises a graphic.

16.   The method of claim 10, wherein the determined print attribute of interest comprises a font name.

17.   The method of claim 10, wherein the determined print attribute of interest comprises a font size.

18.   The method of claim 10, wherein the determined print attribute of interest comprises a color space.

19.   The method of claim 18, wherein the color space comprises a red, green, blue color space.

20.   The method of claim 18, wherein the color space comprises a cyan, magenta, yellow color space.

21.   The method of claim 18, wherein the color space comprises a device-dependent color space.

22.   The method of claim 18, wherein the color space comprises a device-independent color space.

23.   The method of claim 10, wherein the determined print attribute of interest comprises a color value.

24.   The method of claim 23, wherein the color value comprises a red, green, blue color value.

25.   The method of claim 23, wherein the color value comprises a cyan, magenta, yellow color value.

26.   The method of claim 23, wherein the color value comprises a spot color value.

28.   The method of claim 10, wherein the determined print attribute of interest comprises an orientation.

29.   The method of claim 10, wherein the unique marker comprises text.

30.   The method of claim 10, wherein the unique marker comprises sound.

31.   The method of claim 10, wherein the unique marker comprises changing the color of the matched object.

32.   The method of claim 31, wherein reporting comprises displaying the matched object on a display device in the changed color.

33.   The method of claim 31, wherein reporting comprises printing the matched object in the changed color.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.